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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,426	02/13/2004	Gerhard Graab	22750/441A	9062

7590 03/24/2005

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One Broadway
New York, NY 10004

EXAMINER

LEE, EDMUND H

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/779,426

Applicant(s)

GRAAB ET AL.

Examiner

EDMUND H. LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/542,234.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/13/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "in particular made of epoxy resin" (cl 13, lns 2-3) is indefinite because the metes and bounds of the phrase are unascertainable.

Correction is required.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Graab et al (USPN 6221462) in view of Saylor, Jr. (USPN 5613332). Graab et al teach the basic claimed process including a method of forming a web-type floor covering (figs 1-5); preparing a quantity of first decorative particles (figs 1-5); preparing an uncured rubber web having a top side (figs 1-5); applying the particles to the top side of the web (figs 1-5); attaching the particles to the web via pressure (figs 1-5); and vulcanizing the web having the particles (figs 1-5). Graab et al, however, do not teach using particles having a coating. Saylor, Jr teach a method of forming a floor mat (col 2, ln 55-col 3, ln 25); preparing a polyurethane layer (col 2, ln 55-col 3, ln 25); preparing a plurality of beads having a coating thereon that enhances bonding between the beads and the polyurethane layer (col 5, lns 35-45); and embedding the coated beads into the

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polyurethane layer (col 2, ln 55-col 3, ln 25). Graab et al and Saylor, Jr are combinable because they are analogous with respect to forming a floor covering having particles/beads therein. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the coating of Saylor, Jr onto the particles of Graab et al in order to enhance the bonding between the particles and rubber of Graab et al.

4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller, Jr et al (USPN 4348447) in view of Saylor, Jr. (USPN 5613332). Miller, Jr et al teach the basic claimed process including a method of forming a web-type floor covering (figs 1-3); preparing a quantity of first decorative particles (figs 1-3); preparing an uncured rubber web having a top side (col 2, ln 50-col 3, ln 30; figs 1-3); applying the particles to the top side of the web (figs 1-3); attaching the particles to the web via pressure (col 5, lns 20-30; figs 1-3); and vulcanizing the web having the particles (figs 1-3). Miller, Jr et al, however, do not teach using particles having a coating. Saylor, Jr teach a method of forming a floor mat (col 2, ln 55-col 3, ln 25); preparing a polyurethane layer (col 2, ln 55-col 3, ln 25); preparing a plurality of beads having a coating thereon that enhances bonding between the beads and the polyurethane layer (col 5, lns 35-45); and embedding the coated beads into the polyurethane layer (col 2, ln 55-col 3, ln 25). Miller, Jr et al and Saylor, Jr are combinable because they are analogous with respect to forming a floor covering having particles/beads therein. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the

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coating of Saylor, Jr onto the particles of Miller, Jr et al in order to enhance the bonding between the particles and rubber of Miller, Jr et al.

5. Claim 13 would be allowable if the above 35 USC 112, 2nd paragraph rejection is overcome and the claim is amended to be include all the limitations, i.e., commensurate in scope, with claim 1 of the patented parent application 09/542234 (USPN 6709732).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 571.272.1204. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571.272.1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EHL

EDMUND H. LEE
Primary Examiner
Art Unit 1732

Edmund H. Lee
3/16/07